

REMARKS

The present amendment is in response to the Office Action where the Examiner has rejected claims 1-35. By the present amendment, claims 1-35 are canceled and new claims 36-60 are added. Applicant maintains four (4) independent claims 36, 47, 48, and 60 which are comparable to the canceled independent claims 1, 16, 17 and 35. Reconsideration and allowance of the pending claims in view of the amendments and the following remarks are respectfully requested.

A. Objection to the Abstract

Applicant amends the Abstract to limit the length within the range of 50 to 150 words, and to comply with the criteria outlined by the Examiner on page 2 of the Office Action.

B. Rejection of Independent Claims 35 under 35 U.S.C. §102(e)

The Examiner rejects independent claims 1, 17 and 35, and additional dependent claims, under 35 U.S.C. 102(e) as being anticipated by the Helferich patent (U.S. Patent No. 5,884,193). Applicant has canceled claims 1-35 and adds claims 36-60 due to a need to correct a number of antecedent basis errors in the claims and in order to clarify the method and device of the claims. *However, Applicant asserts that the new claims do not add any limitations beyond those presented in the original claims.* Applicant respectfully traverses the Examiner's rejections of the prior claims as applied to the new independent claims discussed below.

To anticipate a claim under 35 U.S.C. sections 102(a), (b), or (e), the reference must teach every element of the claim. (See MPEP 2131.) "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." (Emphasis added) (Verdegaal Bros. v. Union Oil Co. of California; see also MPEP 2131.) "The identical invention must be shown in as complete detail as is contained in the ... claim." (Richardson v.

Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); see also MPEP 2131) Further any claim depending from base claims not anticipated or made obvious by the prior art also are not anticipated or made obvious by the prior art since the dependent claims comprise all of the elements of the base claims.

Applicant asserts that the Helferich patent does not teach every element of independent claims 36, 47, 48 and 60, and thus, these independent claims, and the claims dependent thereupon, are patentable over the Helferich patent as discussed below.

The Helferich Patent (U.S. 6,462,646). The Helferich patent teaches a paging system which notifies a paging transceiver that a message has been received, but which does not initially transmit the associated message. (See column 3, lines 15-18.) The user, upon being notified of the message, can then download the entire message at a time convenient to the user. (See column 3, lines 18-20.) "The user then determine the priority of the message and whether he or she wants to retrieve the message, play the message, erase the message, store the message, forward, reply, or otherwise act on the message." (See column 3, lines 35-38.) *Thus, the Helferich patent discloses the system and method for receipt of messages in contrast to the present application which teaches a method and system for broadcasting messages.* The Helferich patent discloses forwarding, replying to, or otherwise acting upon the received message, but these actions are directed to how the user wishes to proceed once he or she accepts a page. (See, for example, Helferich, Column 10, lines 38-63.) In contrast, the independent claims comprise, among other things, delivery status options - that is, selectable options to notify a user whether the intended recipient of a message has received the message; recipient message response options - that is, actions taken by the broadcasting device if a particular recipient responds to the broadcast message; and recipient non-receipt options - that is, actions taken by the

broadcasting device if a particular intended recipient does not receive the broadcast message.

Since the Helferich patent does not teach each and every element of the independent pending claims, inter alia, the selection of delivery status options, and since the other cited references of Wagner and Chaco fail to cure the deficiencies of the Helferich patent, as discussed further below, Applicant respectfully requests that the Examiner issue a notice of allowance for all of the pending independent claims, and the remaining claims dependent thereupon.

1. Independent claim 36, and dependent claims 37-46

Independent claim 36, and dependent claims 37-46, (which correspond to cancelled claims 1-15) are not anticipated by Helferich under 35 U.S.C. §102(e) since Helferich fails to teach or suggest each and every element of independent claim 36. Specifically, claim 36 comprises, among other things, "selecting at least one delivery status option of a plurality of delivery status options." Helferich does not teach this element of claim 36, among other things. As disclosed in the present specification, the "delivery status option" refers to notification to a user of whether the intended recipient has received the broadcast message. (See specification of the present invention, Figure 5, steps 502, 502a-502d.) Helferich neither teaches nor suggests user selectable options for identifying - at the broadcasting device - whether the broadcast message was received.

On Page 3 of the Office Action, with respect to canceled claim 4, which is partially incorporated into new claim 36, the Examiner asserts that Helferich discloses selecting delivery options in Column 3, lines 42-48, Column 6, lines 10-25, and Column 9, lines 62-67. A review of these cited lines, reveals otherwise. Specifically, Column 3, lines 42-28 of Helferich discloses a timer for performing a desired function on a message at a particular time, but does not disclose Applicant's method of "selecting at least one delivery status option" which concerns whether/how a message is received by an intended recipient. Column 6, lines 10-25 of Helferich discusses a delay circuit, and

not a method for selecting "at least one delivery status option" as claimed by Applicant.

Column 9, lines 62-67, discloses that if a pager is required to send an acknowledgment to a system or base station then the selective call signals were received. The Helferich patent does not disclose allowing a user to select options for identifying whether an intended recipient has received a message. Thus, since Helferich does not teach each and every element of claim 36, the Helferich patent does not anticipate claims 36-46 under 35 U.S.C. §102(e).

2. Independent claim 47

Independent claim 47 (which corresponds to canceled claim 16, rejected only under 35 USC 103(a)) is not anticipated by Helferich under 35 U.S.C. §102(e) since Helferich fails to teach or suggest each and every element of independent claim 47. Specifically, claim 47 comprises, inter alia,

"selecting delivery status options for each recipient of the set of recipients, the delivery status options comprising:
 identifying the recipient addresses receiving the broadcast message,
 identifying the recipient addresses with answering machines receiving the broadcast message, and
 identifying the recipient addresses not receiving the broadcast message"

Helferich does not teach the step of selecting delivery status options as claimed in claim 47. Furthermore, the Wagner and Chaco references fail to cure this deficiency.

3. Independent claim 48, and dependent claims 49-59

Independent claim 48, and dependent claims 49-59, (which correspond to canceled claims 17-34) are not anticipated by Helferich under 35 U.S.C. §102(e) since Helferich fails to teach or suggest each and every element of independent claim 48. Specifically, claim 48 comprises, among other things,

"a broadcast circuit connected to the message memory, the recipient memory and the user interface, the broadcast circuit for controlling a broadcast of the

message in accordance with the delivery status option selections, the recipient message response option selections, and the recipient non-receipt option selections."

Delivery status options are not disclosed by Helferich. On page 13 of the Office Action, with respect to canceled claim 20, which is partially incorporated into new claim 48, the Examiner asserts that Helferich discloses a broadcast circuit that includes and input to accept broadcast delivery option selections in Column 3, lines 42-58, Column 6, lines 10-25, and Column 9, lines 62-67. A review of these cited lines reveals otherwise as discussed above with reference to Independent claim 36. In addition, the Examiner cites Column 2, lines 34-36 of Helferich as disclosing this limitation. This part of the Helferich disclosure is in the Background of the Invention and states that "[i]f the base station does not receive this reply or acknowledgment, then the base station assumes that the message has not been received and will repeatedly transmit the message until the reply or acknowledgment is received." (See Column 2, lines 34-36.) In contrast, the method of claim 48, provides for a broadcast circuit in the wireless communications device (not a base station) which controls the rebroadcasting, if necessary based upon the delivery status option selections. Thus, since Helferich does not teach each and every element of claim 48, the Helferich patent does not anticipate claims 48-59 under 35 U.S.C. §102(e).

4. Independent claim 60

Independent claim 60 (which corresponds to canceled claim 35) is not anticipated by Helferich under 35 U.S.C. §102(e) since Helferich fails to teach or suggest each and every element of independent claim 60. Specifically, claim 60 comprises, inter alia,

"a broadcast circuit ... connected to the user interface to accept the selected delivery status option selections, the broadcast circuit creating a broadcast message comprising the selected message and compliance instructions based upon the selected delivery status option selections."

Helferich does not teach a broadcast circuit creating a broadcast message comprising elected delivery status option selections as claimed in claim 60. Furthermore, the Wagner and Chaco references fail to cure this deficiency. (See comments "regarding compliance instructions" in the discussion of the Wagner patent below.)

C. Rejections of Independent Claims Under 35 U.S.C. §103(a)

The Examiner rejects dependent claims 5-16 and 19-34 (now canceled) under 35 U.S.C. §103(a) as being unpatentable over Helferich in view of Wagner (U.S. Patent No. 6,282,435) and/or in view of Chaco (U.S. Patent No. 6,009,333). Applicant asserts that new dependent claims 37-46 and 49-59 are dependent upon patentable independent claims as discussed above, and therefore are patentable. That is, the independent claims are patentably distinguishable over the Helferich patent, and, as such, the claims depending therefrom are, a fortiori, also patentably distinguishable over the Helferich patent. Furthermore, the disclosures of the Wagner and Chaco patents fail to cure the basic deficiencies of the Helferich patent, and as such, the combined references of Helferich, Wagner and Chaco cannot result in the device or methods specified by claims 36-60.

An invention is unpatentable under 35 U.S.C. §103(a) if the differences between it and the prior art would have been obvious at the time of the invention. As stated in MPEP § 2143, there are three requirements to establish a *prima facie* case of obviousness.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must both be found in the prior art and not

based on applicant's disclosure. *In re Vaeck* 947 F.2d 488, 20 USPQ2d, 1438 (Fed. Cir. 1991).

With respect to the first *prima facie* requirement, there is no motivation or suggestion to combine the Helferich, Wagner and Chaco references in such a manner as to make the claimed invention obvious. Neither has it been demonstrated that the modification of the cited reference points to the reasonable expectation of success in the present invention, which is the second requirement of the obviousness analysis. With respect to the third requirement to support a *prima facie* case of obviousness, the three references do not teach all the limitations of the claims.

Applicant respectfully traverses all of the Examiner's rejections based upon all of the specific cites to the Wagner and Chaco patents as discussed below. Obviousness rejections of the dependent claims in view of the Helfrich patent are discussed above with respect to the independent claims. That is, since Helfrich does not teach or suggest each and every element of the independent claims, and the Wagner and Chaco patents do not cure the basic deficiencies of Helfrich, then the independent claims, and the corresponding dependent claims, are patentable over Helfrich in view of Wagner and Chaco.

The Wagner Patent (U.S. 6,282,435). The Wagner Patent discloses a portable telephone which utilizes a graphical user interface which allows a user to access both stored electronic mail messages and voice messages from the single display screen. The Examiner cites Wagner on page 7 of the Office Action as a reference that discloses selecting recipients, telephones, e-mail etc. (See Wagner, Col. 6, lines 41-50, Fig. 4.) Wagner is also cited on page 11 of the Office Action as a reference that discloses establishing macros with blank fields and completing the fields. Specifically, Wagner discloses a system which provides standard templates of reply forms. (See Wagner, Col. 7, lines 1-23.) The user interface displays templates having generic

replies that may be chosen in response to a sent e-mail. (See Wagner, Figure 6.) Use of macros for creating a message are claimed in dependent claims 45 and 60.

However, the Wagner patent does not teach each and every element of the independent claims, and does not cure the deficiencies of the Helferich patent or the Chaco patent. That is, the combination of Helferich, Wagner and Chaco to not teach or suggest the device and method of claims 36-60 which comprises, among other things, allowing selection of delivery status options, recipient message response options and recipient non-receipt options as associated with each intended recipient of a broadcast message.

Regarding specific rejections in view of Wagner, on page 14 of the Office Action, the Examiner states that Wagner discloses a broadcast circuit that establishes compliance instructions, and a transceiver which is responsive to the compliance instructions. Applicant respectfully traverses the Examiner's statements. Specifically, Col. 4, lines 38-55 of Wagner, as cited by the Examiner discloses an automatic reply feature that allows a user to automatically initiate a reply with a touch of a button, and an "advanced call control" in which outgoing phone calls are intercepted to determine whether the dialed phone number is valid, and suggests alternative phone numbers when appropriate. Col. 3., lines 23-41 of Wagner, as cited by the Examiner, merely disclose internal components of the Wagner device, including a transceiver. Wagner does not teach or suggest the device of claims 50-52 and of claim 60. Specifically, the "compliance" instructions of Applicant's claims 50-52 and 60 are supplied along with the message broadcast to the recipients so that the recipients can comply with the selected options. For example, if the option of receiving a response from recipients is selected, the recipients must be informed that a reply is desired, and the wireless communications device must be prepared to accept response transmission from the recipients. (See Applicant's disclosure paragraph 0023 and 0024, as published in US 2003/0137401A1.) Wagner does not disclose system and device in which the user pre-selects options, which options are then utilized by a broadcast circuit to create compliance instructions for including with the broadcast message. Thus, Applicant

asserts that the cites to Wagner regarding compliance instructions is unsupported, and respectfully requests that the Examiner issue a notice of allowance for all of the pending independent claims and the claims dependent thereupon.

The Chaco Patent (U.S. 6,009,003). The Chaco Patent discloses a telephone communication system having a locator and a scheduling facility. The system includes a private branch exchange with a processing unit, a plurality of telephones, a scheduling unit, and a locator system. The locator system includes a set of portable units each associated with a respective one of a plurality of users and transmits unit information including an identification signal for identifying the user associated with the respective unit. (See Chaco, Col. 2, lines.3-7.) The Examiner cites Chaco *only* on Page 8 of the Office Action with reference to a device which provides a single function key for initiating a function. (See Chaco, Column 7, lines 13-18 and Figure 2). A one command initiation of a broadcast of messages is found in a dependent claim 38, only. However, the Chaco patent does not teach each and every element of the independent pending claims, and does not cure the deficiencies of the Helferich patent or the Wagner patent, namely, the device and method allowing selection of delivery status options, recipient message response options and recipient non-receipt options as associated with each intended recipient of a broadcast message. Thus, Applicant respectfully requests that the Examiner issue a notice of allowance for all of the pending independent claims and the claims dependent thereupon.

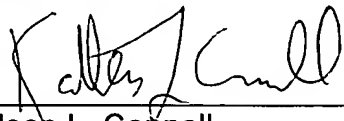
D. Conclusion

Applicant asserts that claims new claims 36-60 are neither anticipated by Helferich under 35 U.S.C. 102(e) nor unpatentable over Helferich in view of Chaco and/or Wagner under 35 U.S.C. 103(a) as discussed above. Thus, Applicant respectfully requests that the Examiner issue a notice of allowance for all of the pending claims 36-60.

Should the Examiner believe that prosecution of this application might be expedited by further discussion of the issues, he is invited to telephone the attorney for Applicant at the telephone number listed below.

Respectfully submitted,

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